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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,630	09/20/2000	Kaushal Kurapati	US000240	5682

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER

SLOAN, NATHAN A

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 04/21/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/666,630

Applicant(s)

KURAPATI, KAUSHAL

Examiner

Nathan A Sloan

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Advisory Action

1. The declaration and corresponding request for reconsideration have been entered and considered but does not overcome the rejection. In the final office action mailed 1/28/04, the examiner stated that the submitted evidence fails to establish conception of the invention prior to the effective date of the Labeeb reference. While dates may be redacted, **conception must be capable of proof** such as by drawings (MPEP 715.07). Conception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill (MPEP 2138.04). In the previously submitted exhibit, applicant fails to establish conception of a complete invention, capable of proof, that could be reduced to practice without exercise of inventive skill. Applicant merely provides an exhibit which describes a program recommendation system at a very high level with desired outcomes. No system drawings, discussion of hardware implementation, system design, notations of where data is collected (locally or remotely), or any other supporting details are provided which would allow reduction to practice without inventive skill. Rather, the exhibit briefly describes a goal of creating two recommendation scores to recommend programs in a time period. This amounts to a vague idea of how to solve a problem without the means themselves and their interaction, which is explicitly stated in MPEP 715.07 to fail to establish conception.

Thus, the previously submitted exhibit fails to establish conception. Correspondingly, the statement by the inventor which attempts to establish conception prior to the date of Labeeb is not found convincing as no adequate proof of conception is provided. In light of this and

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according to MPEP 2138.06, conception is established at least as early as the date of preparation of a draft application by an attorney on behalf of the invention. In the present affidavit, applicant clearly shows that a first draft was sent to the invention by a Mr. Mason on August 14, 2000.

Aside from the fact that Mr. Mason does not appear to be an attorney of record in this case, the date of the draft being August 14, 2000 fails to establish conception prior to the date of the Labeeb reference: June 30, 2000.

Additionally, the declaration asserting diligence by the inventors attorney submitted 4/7/04 is not found convincing. MPEP 2138.06 clearly states that the entire period during which diligence is required must be accounted for, noting that a period of only two days has been held to be fatal. This period must be entirely accounted for either by affirmative acts or acceptable excuses. Gaps exceeding a week of action exist throughout the affidavit submitted, including but not limited to periods between: 1) June 21st, reception of the disclosure file, and July 10, interview to discuss the invention, 2) July 10th, initial interview to discuss, and "during the week of August 14th," start of drafting and subsequent interviews, and particularly 3) September 6, 2000, completion of final draft and September 20, 2000, actual submission.

Correspondingly, all previous grounds of rejection stand.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan A Sloan whose telephone number is (703) 305-8143. The examiner can normally be reached on Mon-Fri 7:30am - 6pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703)305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NAS



JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600